

## Remarks and Arguments

Claims 1-22 are pending in this application. Applicant gratefully acknowledges the withdrawal of the rejection under 35 U.S.C. § 112, as well as the art based rejections in light of the Stanchfield and Bloecker references. Claim 13 has been amended to more particularly point out the invention. Support for the amendment is found in the specification in Figure 1.

Claims 1- 9 and 11-22 stand rejected under 35 U.S.C. § 102, in view of U.S. Patent No. 6,159,368 (hereinafter, "Moring") and under 35 U.S.C. § 103 in view of Moring and U.S. Patent No. 5,498,545 (hereinafter, "Vestal"). The Office has objected to claim 10, but has deemed the subject matter allowable if rewritten in independent form including all of the limitations of the base claim. Applicants respectfully traverse the rejections.

### **35 U.S.C. § 102**

The standard for anticipation under 35 U.S.C. § 102 requires that each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites in part:

a first sample processing device;

a second device stacked below said first sample processing device to form an integral stacked unit preventing relative movement between said first and second devices,  
said stacked unit positioned between said collar and said base (emphasis added)

Claim 16 recites in part:

positioning said sample processing unit between said base and said collar;

positioning said collar on said base; and  
applying a vacuum to said manifold with said vacuum source, whereby said collar is forced into sealing engagement with said base without causing movement of said sample processing unit (emphasis added).

In the Office Action dated December 16, 2005, commenting on Moring, the Office stated: "The Examiner considers a deformable gasket (col. 14, lines 28-30) as allowing variability in the height of the processing devices since it may be deformed" (page 3 of the Office Action)(emphasis added). Applicant believes the Office has admitted that Moring does not teach each and every element of the claims because the deformable gasket of Moring allows variability in the height of the processing devices and thus does not meet the limitation that the second device be stacked below said first sample processing device to form an integral stacked unit preventing relative movement between said first and second devices (claim 1 and its dependencies). In this regard the Office is urged to consider Figure 2 in Moring, with particular focus on gaskets (42) and 44, which Applicants believe will result in the relative movement of (10), (34) and (28) with respect to one another when an external force is applied. Applicants believe the same argument applies to claim 16 as well.

Turning to claim 13, Applicants have amended claim 13 to recite in part: "a gasket positioned in the collar which does not contact the sample processing device." Moring does not meet this limitation. Accordingly, Applicants respectfully request withdrawal of the rejection.

### **35 USC §103**

Claims 4 and 22 stand rejected as allegedly obvious in light of Moring in view of Vestal. The Office believes that Moring teaches all the elements of the claims, but admits that none of these references teach a MALDI device as the second device. According to the Office, Vestal teaches a mass spectrometer system for analyzing multiple samples. The Office believes that Vestal discloses a system including a sample plate for holding samples on pins in wells of a plate. The Office concludes it would have been obvious to combine Vestal with the device of Moring. The Office further states that one would use the plate of Vestal as the collection plate in order to

load the collection plate for MALDI analysis of the samples. Applicants respectfully traverse the rejection.

### **The Prima Facie Case Requirement**

The Patent and Trademark Office (PTO) bears the burden of initially establishing a prima facie case of obviousness. MPEP §2142. MPEP §2143 provides the standard required to establish a prima facie case of obviousness. "First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one or ordinary skill in the art, to modify the reference or to combine what the reference teaches. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim limitations." The motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The references must be considered as a whole and must suggest the desirability, and thus the obviousness of making the combination. *Hodosh v. Block Drug Co., Inc.*, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP § 2141. The Office has not met its burden in establishing a prima facie case of obviousness.

For the reasons set forth above, Moring does not teach or suggest every claim limitation of claim 4 or 22. Vestal does nothing to cure this defect. Accordingly the claims are not prima facie obvious.

Lastly Applicants note that the Office has not pointed to anything in the cited references that would motivate the skilled artisan to make the suggested combination. The references themselves must suggest the desirability of making the suggested combination. Applicants believe there is nothing of record that suggests such motivation. Accordingly, Applicants respectfully request withdrawal of the rejection.

### **Objection**

Applicants submit that the objection to claim 10 is deemed moot in light of the remarks presented above.

**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account.

Respectfully submitted

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